

FAX RECEIVED

JUL 15 2003

GROUP 1600

CERTIFICATE OF FACSIMILE TRANSMISSION

This is to certify that this document entitled ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT is being faxed to Examiner SAOUD at fax no. 703-872-9306 this 14th day of JULY, 2003.

W. A. Z. B.

OFFICIAL

#4
N.G.
7/24/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. : 09/787,397

Confirmation No.: 2388

Applicant : GOTO et al.

Filed : May 17, 2001

TC/A.U. : 1647

Examiner : Christine Saoud

Docket No. : FJIN-107

Customer No.: 23290

ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop NON-FEE AMENDMENT

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the June 26, 2003 Restriction Requirement in the above U.S. patent application, Applicants elect Group II (Claims 13-20) with traverse.

Applicants respectfully maintain that the appropriate standard for determining unity of invention has not been applied.

I. UNITY OF INVENTION

Unity of invention exists when there is a special technical relationship among a group of inventions in the same international application involving one or more of the

Appln. No. 09/787,397

ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Docket No. FJIN-107

same or corresponding special technical features. The term "special technical features" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. See PCT Rule 13.2.

As indicated in Part I of Annex B of the PCT Administrative Instructions (Instructions Concerning Unity of Invention), this determination "is made on the contents of the claims as interpreted in light of the description and drawings" (emphasis added). The definition of special technical features does not require any preliminary determination of patentability, contrary to the Examiner's comments based upon the Olsen et al. reference cited on page 4 of the instant specification.

Part 2 of Annex B contains several examples concerning Unity of Invention. In particular, Example 1 shows that the special technical feature may be a composition and that unity of invention exists between claims directed to the composition (Substance X) and claims directed to the use of the composition (use of substance X as an insecticide). Applying Example 1 to the pending claims, the special technical feature common to Claims 1-12 (Group I) and elected Claims 13-20 (Group II) is stanniocalcin, which forms a single general inventive concept. Thus, unity of invention exists for Claims 1-20 under the PCT Rules.

In addition, there is no teaching or suggestion in Olsen et al. that stanniocalcin is an effective preventive and/or therapeutic agent for obesity. The Examiner has also not shown that stanniocalcin obtained from a recombinant expression cell, as recited in Claim 2, is disclosed in any reference. In view of the foregoing remarks, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Appln. No. 09/787,397

ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Docket No. FJIN-107

II. CONCLUSION

If there are any questions regarding this Election or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application.

If there are any discrepancies in the fees, please charge or credit our Deposit Account No. 501032 (Docket No. FJIN-107).

Respectfully submitted,



Warren A. Zitlau

Registration No. 39,085

Tel: (703) 383-4800

Barry I. Hollander

Registration No. 28,566

Tel: (703) 383-4800

Hollander Law Firm, P.L.C.
Suite 305, 10300 Eaton Place
Fairfax, Virginia 22030
Tel: (703) 383-4800
Fax: (703) 383-4804

July 14, 2003